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10/706,334	11/12/2003	David G. Kuehr-McLaren	RSW920010113US1	6032
70854 7590 11/16/2010 WILSON HAM & HOLMAN/RSW 175 S Main Street Suite #850 Salt Lake City, UT 84111			EXAMINER AUGUSTIN, EVENS J	
			ART UNIT 3621	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/706,334  
Filing Date: November 12, 2003  
Appellant(s): KUEHR-MCLAREN ET AL.

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Jeffrey T. Holman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on 08/23/10 appealing from the Office action mailed 02/23/10.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

1-20.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

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REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

**(8) Evidence Relied Upon**

<b>20020029201</b>	<b>Barzilai et al.</b>	<b>3-2002</b>
<b>6697824</b>	<b>Bowman</b>	<b>8-1999</b>

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al. (U.S. 20020029201) (“Barzilai”), in view of Bowman-Amuah (U.S. 6697824) (“Bowman”).

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3. As per claims 1-20, Barzilai discloses an invention comprising of storage medium/software combination means (§ 42-43, 50-52 and figure 1) to perform the following:

A. ("**obtaining digitally-signed privacy-use information for each participant;** "); –

The marketplace prompts the user for privacy policy information, preferably based on a standard form or language for recording privacy preferences and choices, such as an extension of the above-mentioned P3P standard (§ 12, 24, 46). Marketplace also obtains seller's privacy policy (§ 13), which has to match the buyer's;

B. ("**wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants;**") – According to § 14 of the prior art by Barzilai, after the buyer and marketplace have agreed on the privacy policy, the buyer submits a query or purchase order to the marketplace for a desired item of goods or services. The marketplace then finds one or more sellers offering the desired item and attempts to match the privacy policy agreed upon with the buyer to the sellers' proposed privacy policies. Therefore, the policy is agreed upon separately from the actual transaction itself. The parties still have to agree on pricing and terms of the transaction § 77, independent of privacy policy.

C. ("**sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace**") –

Marketplace shares buyer's privacy policy with sellers that have compatible policies (§ 14, 22, 24);

D. The information is made available to all eligible to receive the information (i.e., buyers and sellers) (§22, 24);

- E. ("requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace ")** –With regard to the registration process, Merriam-Webster's dictionary describes register as: "1 a: to make or secure official entry of in a register b: to enroll formally especially as a voter or student c: to record automatically : indicate d: to make a record of : note e: perceive;". The prior art teaches that a buyer, seeking to purchase an item of goods or services of a particular type, logs into the market maker's Web site, at a log-in step 30 (¶ 54). According to Merriam-Webster's dictionary, to log is described as: "2: to make a note or record of : enter details of or about in a log ". In this case, log-in step is equivalent to the registration step because both take entries of information about the users;
- F. ("and storing all of said submitted digitally-signed privacy-use information")** – Storing information (¶ 14, 79);
- G. Regarding the aspect of "E-marketplace sending the digitally-signed privacy-use information of a potential business partner to a buyer in conjunction with the buyer requesting information regarding the potential business partner, prior to OR after the buyer selecting to do business with the potential business partner",** ¶ 13-14 of the prior art teaches that seller is selected or matched with buyer's preferences before he or she signs the privacy policy. However, the transaction does not get consummated until the after policy is signed and terms of the transaction are agreed upon. It is not clear at what point during the transaction a buyer selects to do business with a potential seller. It may be when a seller is selected to participate in a

transaction. It may also be when the terms of the transaction are agreed upon between seller and buyer (until then, there can't be any transaction).

H. Either way, it would have been obvious for one of ordinary skill at the time of applicant's invention to agree on a privacy policy before or after the selected has been selected by buyer. In either case, the privacy policy is agreed before the transaction is completed. The motivation behind the privacy policy is to put buyers in control and hold sellers accountable for buyer's private data during transaction.

4. Barzilai did not explicitly describe an invention in which the privacy information received from the users is digitally signed.
5. However, Bowman describes an e-commerce environment in which information received from sender/receiver is digitally signed (Col. 68, Lines 20-26). Regarding the aspect of sharing allows participants to verify that the privacy policy has not been tampered with, Bowman teaches that during data transmission a digest is used to provide data-integrity. A digest is associated with a sent message. The recipient can recompute the digest and compare the new one with the sent one. If they match, the message has not been tampered during transmission. Bowman also uses digital signatures to ensure the message recipient only the sender of the message could have sent it (Column 70, Lines 58-62). This is similar to the way digital signature is used in the current invention (Published specification, ¶ 25-26).
6. Therefore, it would have been obvious for one skilled in the art, at the time of applicant's invention to implement digital signature in an invention that deals with privacy in an electronic marketplace.

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7. The motivation for doing so would be to ensure that the identities of the sender and receiver of information in a digital marketplace are known and the information sent arrives unaltered (Bowman, Col, 70, Lines 28-34 and 58-67).

#### **(10) Response to Argument**

Appellant made the argument that privacy-use information is not the same as private information, as taught by the prior art by Barzilai (see brief, page 6, end of first paragraph). Appellant's specification does not set forth any framework or description of "privacy-use information" that would discourage the Examiner from making any broad interpretation of the term. According to MPEP 2111, "during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." The term can be interpreted as private information, since privacy use information is not defined in the specification. Therefore, the privacy-use information is being examined as user privacy preferences or users controlling whom and how their private information is shared. These criteria specified by the buyer, can be" size, visibility, affiliation with industry groups, customer privacy protection record, etc. (It is assumed that data regarding these criteria are available to the marketplace.)" (par. 73). In other words, the user's privacy-use information is made available or shared to the entire marketplace (buyers and sellers). Further evidence that the user's privacy preference is to shared to seller(s) can be found in par. 75, where the user's preference may not acceptable to a particular seller. Other evidence can be found in par. 79, where "both the market maker and the seller are required to determine whether the privacy policy agreed upon with the buyer allows either of them to make further use of the information provided in the course of the transaction".



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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621

Conferees:

/Vincent Millin/

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Primary Examiner, Art Unit 3621

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Limitations	Claim 1	US 20020029201	US 7073063
1	E-marketplace obtaining, via a computer, digitally-signed privacy-use information for each participant	The marketplace prompts the user for privacy policy information (§ 12, 24, 46). Marketplace also obtains seller's privacy policy (§ 13), which has to match the buyer's;	
2	wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants	According to § 14 of the prior art by Barzilai, after the buyer and marketplace have agreed on the privacy policy, the buyer submits a query or purchase order to the marketplace for a desired item of goods or services. The marketplace then finds one or more sellers offering the desired item and attempts to match the privacy policy agreed upon with the buyer to the sellers' proposed privacy policies. Therefore, the policy is agreed upon separately from the actual transaction itself. The parties still have to agree on pricing and terms of the transaction § 77, independent of privacy policy.	
3	E-marketplace sharing, via said computer, the digitally-signed privacy-use information with any participants interested in doing business with each other in the E- marketplace	Marketplace shares buyer's privacy policy with sellers that have compatible policies (§ 14, 22, 24);	
4	wherein the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E- marketplace.		The recipient can recompute the digest and compare the new one with the sent one. If they match, the message has not been tampered during transmission. Bowman also uses digital signatures to ensure the message recipient only the sender of the message could have sent it (Column 70, Lines 58-62). This is similar to the way digital signature is used in the current invention (Published specification, § 25-26). 7. Therefore, it would have been obvious for one skilled in the art, at the time of applicant's invention to implement digital signature in an invention that deals with privacy in an electronic marketplace.